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40055-0001

Serial No.: 10/635,362

JUL 21 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****In re Patent Application:** Rob Falke**Application No.:** 10/635,362**Filed:** August 5, 2003**Title:** "Method and Apparatus for Storing and Preserving Writings and Memoranda"**Examiner:** WILKENS, Janet Marie**Group Art Unit:** 3637**Confirmation No.:** 8884

Mail Stop Appeal Brief-Patents  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF****Sir:**

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 23, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **\$250.00**.

(X) Applicant claims small entity status

**(complete (a) or (b) as applicable)**

The proceedings herein are for a patent application and the provision of 37 CFR 1.136 (a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: CFR 1.17(a)-(d)) for the total number of months checked below:

- ( ) one month \$120.00
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- ( ) three months \$1020.00
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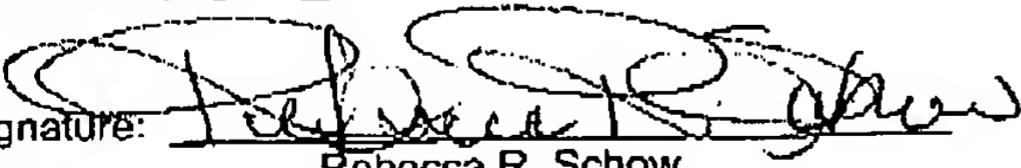
( ) The extension fee has already been filed in this application

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant had inadvertently overlooked the need for a petition and fee for extension of time.

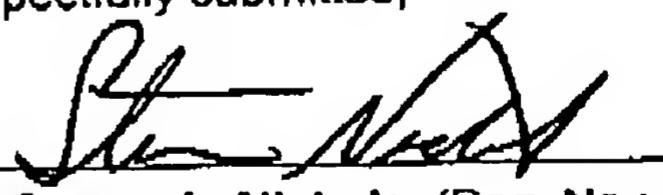
Please charge to Deposit Account 18-0013/40055-0001 the sum of **\$250.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 18-0013 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 18-0013 under CFR 1.16 through 1.21 inclusive, and any other section in the Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on July 21, 2006.

Number of pages: 19

Signature:   
 Rebecca R. Schow

Respectfully submitted,

By: 

Steven L. Nichols (Reg. No.: 40,326)  
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 Date: July 21, 2006

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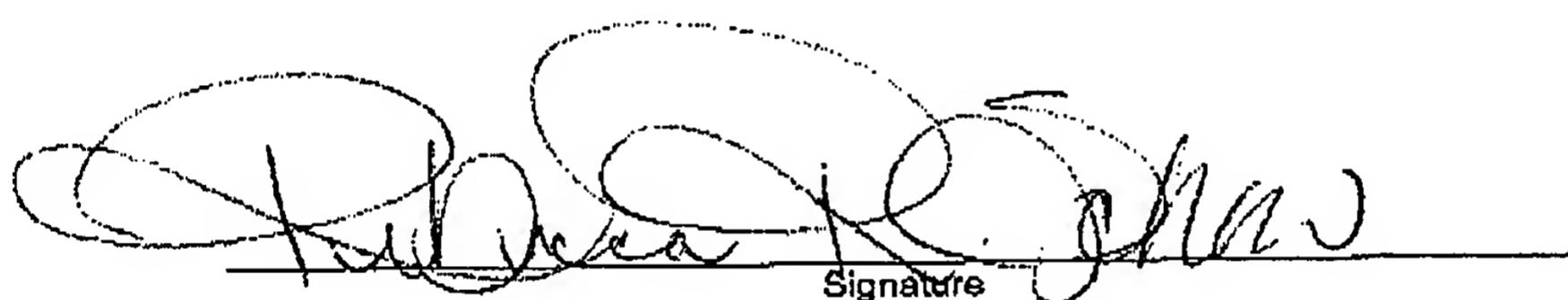
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10/635,362

JUL 21 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of:

Rob Falke

Application No. 10/635,362

Filed: August 5, 2003

For: Method and Apparatus for Storing and  
Preserving Writings and Memoranda

Group Art Unit: 3637

Examiner: WILKENS, Janet Marie

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief under Rule 41.37 appealing the final decision of the Primary Examiner dated February 24, 2006. Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

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**I. Real Party in Interest**

The present application has not been assigned. Consequently, the Appellant of record, Rob Falke, is the real party in interest.

**II. Related Appeals and Interferences**

There are no appeals or interferences related to the present application of which the Appellants are aware.

**III. Status of Claims**

Claims 16-27 were withdrawn under a previous restriction requirement and have been cancelled without prejudice or disclaimer. Thus, claims 1-15, and 28-32 are currently pending and stand finally rejected. Claims 1-15 and 28-32 are present in the following Appendix. Appellant hereby appeals from the final rejection of claims 1-15 and 28-32.

**IV. Status of Amendments**

Following the final Office Action of February 24, 2006, Appellant filed a single after-final response on April 24, 2006. That response proposed no amendments to the application. Consequently, its entry into the record has no bearing on the claims presented in the Appendix.

**V. Summary of Claimed Subject Matter**

Many people obtain objects throughout their lives that hold some sort of sentimental value or personal worth. Quite often, these people will hand down such objects to another

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member of the family as a means of remembering them. This passing down of heirlooms continues from generation to generation within a family. (Appellant's specification, paragraph 0001). Many times a piece of furniture has been in a family for generations, passed on from one member to the next. In such cases, the furniture piece is, understandably, quite valuable to its owner. It provides a link to family members who once lived, a means of preserving their past. (Appellant's specification, paragraph 0003).

Writings, drawings, paintings and the like are also methods of preserving the past. Similar to the aforementioned piece of furniture, writings and other recordings may also be passed on within a family for generations, thus providing a link to the past. In this way, these writings and other recordings become heirlooms within a family. (Appellant's specification, paragraph 0004).

Appellant's specification describes a method and system for storing and preserving writings and memoranda to enhance the value of an heirloom. The writings and memoranda are stored in and/or on a piece of furniture *specifically designed for storing such writings*. The term "writings" may include, but is not limited to, handwritten letters, words, phrases, names, initials, signatures, drawings, sketches, paintings, or any other form of markings. Writings may be made, for example, with any one or more of the following: pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, brush, imprint, stamp, etc. The writing surface is of a material from which the furniture itself is made, such as wood, plastic, metal, ceramic, marble or other material, which may be marked. (Appellant's specification, paragraph 0017). In a variety of examples, the writings may be stored on planks, tablets or drawers built into, on or attached to (e.g., hinged to) the piece of furniture. (Appellant's specification, paragraph 0018).

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These writings may be the name of a person, his or her signature, and/or the date. The writings may also include other words, genealogical forms, historical event formats and phrases describing the person, an event, or time of significance. The writings may be written on the surface of the drawer with a writing instrument. Alternatively, the writings may be carved, burned, chiseled, drawn, etched, stamped, laser carved, painted, or otherwise marked onto the surface of the plank (105), tablet (820, FIG. 8) or drawer (106, FIG. 3). The piece of furniture (101) serves as a protection to the writings, thus preserving them for future generations. (Appellant's specification, paragraph 0021).

The piece of furniture (101) may also be associated with a set of instructions (130) that explain the intended use of the plank, tablet or drawer as a surface to receive writings or other markings that record history, e.g., the history of the furniture owner or owners. The furniture (101) may be offered for sale with the instructions (130) associated with the furniture, e.g., tied, taped or secured to the furniture or displayed with the furniture. (Appellant's specification, paragraph 0023).

#### VI. Grounds of Rejection to be Reviewed on Appeal

In the final Office Action, the following grounds of rejection were made:

- (1) Claim 12 was rejected under 35 U.S.C. § 112, second paragraph; and
- (2) Claims 1-14 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 1,569,486 to Hardin ("Hardin") taken alone.
- (3) Claims 1-5, 8-15 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 6,735,831 to Greiwe et al. ("Greiwe") taken alone.

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(4) Claims 1-3, 6-11, 28 and 30-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 668,582 to McClintock ("McClintock") taken alone. Appellant hereby request review of each of these four grounds of rejection on the present appeal.

## VII. Argument

### Claim 12 (35 U.S.C. § 112, Second Paragraph):

The Office Action rejected claim 12 under 35 U.S.C. § 112, second paragraph, because, according to the Action, "it is unclear how carving, wood burning, etching, brush marks, imprints and stamps can be considered handwritten writings." (Action of 2/24/06, p. 3). Appellant respectfully disagrees. In carving, wood burning, etching, etc. a human uses an instrument, such as a knife, wood burner, etc., to produce writing. This writing is thus handwritten in the same sense as if the writer were holding a pen or pencil. On this point, Appellant's specification expressly states that: "Writings may be made, for example, with any one or more of the following: pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, brush, imprint, stamp, etc." (Appellant's specification, paragraph 0017). Consequently, claim 12 is thought to be clear and consistent with the other claims. Thus, the rejection of claim 12 under § 112, second paragraph, should not be sustained.

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Claims 1-15 and 28-32 (Prior Art):

Appellant's specification describes "a method and system for storing and preserving writings and memoranda to enhance the value of an heirloom. The writings and memoranda may be stored and preserved in a variety of methods. In one embodiment, the writings will be stored in and/or on a piece of furniture specifically designed for storing such writings." (Appellant's specification, paragraph 0017). In the embodiment claimed, the writings are made directly on a surface of the furniture specifically intended for that purpose. As stated in Appellant's specification, "the writing surface may be any type of wood, plastic, metal, ceramic, marble or other material, which may be marked." (*Id.*). "More specifically, the writings may be stored on planks, tablets or drawers built into, on or attached to (e.g., hinged to) the piece of furniture." (Appellant's specification, paragraph 0018).

This concept appears expressly in Appellant's claim 1. Claim 1 recites: "A method for storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises *a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" (emphasis added). Thus, claim 1 expressly recites that the surface receiving the handwritten writings is of "a material used to construct the furniture," e.g. wood, plastic metal, etc.

In contrast, the three prior art references cited generally do not teach or suggest the claimed method in which a surface of a material that is used to construct a piece of furniture is configured to permanently receive handwritten writings. Rather, the prior art references cited

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either do not teach or suggest handwritten writings or merely teach temporarily securing a piece of paper that may bear handwriting to some furniture-like structure.

For example, Hardin teaches a desk in which sheets of paper may be kept under a transparent plate. According to Hardin, "the sheets bearing the memoranda, data, or other subject-matter are placed between the mat and glass plate for inspection through the transparent plate." (Hardin, lines 82-87). Hardin does not teach or suggest the claimed method in which handwritten writings are stored on a surface of a material used to construct a piece of furniture that is configured to permanently receive such writings.

Griewe teaches a "cremation remains container" that includes a memorial plaque (70). However, the plaque taught by Griewe is not "handwritten." Griewe does not teach or suggest that the plaque can be handwritten. One of skill in the art would not conclude that the plaque taught by Griewe is handwritten. To the contrary, viewing the illustrations provided by Griewe, the plaque (70) is clearly *not* handwritten. Thus, Griewe does not teach or suggest the claimed method of storing handwritten writings with furniture having a surface configured to permanently receive handwritten writings. There is no teaching or suggestion in Griewe of a surface specifically configured to permanently receive *handwritten* writings as claimed.

Lastly, McClintock does not teach or suggest the claimed method for storing handwritten writings on a piece of furniture, where the furniture comprises "*a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" Rather, McClintock, merely teaches a "tablet file case" in which "file drawers" (4) include fasteners (17) that are used to secure papers including "different printed forms" in the file drawer (4). (McClintock, page 2, lines 1-17).

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Thus, McClintock, similar to Hardin, merely teaches a method of securing printed paper forms to structure, in this case a file drawer. McClintock does not teach or suggest the claimed method of "storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises *a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" (emphasis added).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejections based on Hardin, Greiwe and McClintock should not be sustained.

In making the foregoing rejections under § 103, the Office appears to assume subject matter or read teachings into the prior art that are not actually there. To the extent that the Office is attempting in these instances to take "official notice," Appellant invokes Appellant's right to request that prior art supporting the official notice be made of record.

"The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F. 2d 1088, 165 USPQ 418, 420 (CCPA 1970). . . . If the Appellant traverses such an assertion the examiner should cite a reference in support of his or her position." M.P.E.P. § 2144.03.

Specifically, Appellant had requested, prior to filing this appeal, that the Office cite prior art that shows actual *handwritten* writings on a surface of a material used to construct a piece of furniture as recited in claim 1. This request was ignored.

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Claim 2:

Claim 2 recites: "The method of claim 1, further comprising preparing said member with markings to facilitate placement of said writings on said member." Appellant had requested, prior to filing this appeal, that the Office cite prior art showing markings on a surface of a material used to construct a piece of furniture that are to facilitate the placement of handwritten writing (claim 2). This request was ignored.

Claim 6:

Claim 6 recites: "The method of claim 3, wherein said member comprises a drawer." Appellant had requested, prior to filing this appeal, that the Office cite prior art actually teaching handwritten writings on a drawer (claim 6) of a piece of furniture, rather than merely on paper attached to a drawer. This request was ignored.

Claim 10:

Claim 10 recites: "The method of claim 9, wherein said writings comprise a signature." Appellant had requested prior to filing this appeal that the Office cite prior art teaching a handwritten *signature* on a surface of a material used to construct a piece of furniture (claim 10). None of the cited prior art references even mention a signature. This request was ignored.

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Claim 14:

Claim 14 recites: "The method of claim 2, wherein said markings comprise grooves." Appellant had requested, prior to filing this appeal, that the Office cite prior art teaching that such markings are grooves (claim 14). This request was ignored.

Claim 28:

Claim 28 recites: The method of claim 1, further comprising specifically designating said member as being intended to receive said handwritten writings in materials presented with said furniture when said furniture is offered for sale and has not yet received said handwritten writings." Appellant had requested, prior to filing this appeal, that the Office cite prior art actually teaching materials presented with furniture at the time of sale that designate a member of the furniture are being intended to receive the handwritten writings (claim 28). No such teachings has been indicated in the prior art. *In fact, the recent final Office Action does not appear to even attempt to address the subject matter of claim 28.*

Claim 30:

Claim 30 recites: "The method of claim 2, wherein said markings comprise a genealogical form." Appellant had requested, prior to filing this appeal, that the Office cite prior art actually teaching a genealogical form on a surface of a material used to construct a piece of furniture (claim 30). No such subject matter has been indicated in the prior art, and Appellant's request was ignored.

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In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Final Rejection of February 24, 2006 is respectfully requested.

Respectfully submitted,



Steven L. Nichols  
Registration No. 40,326

DATE: July 21, 2006

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Rebecca R. Schow	

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VIII. CLAIMS APPENDIX

1. (previously presented) A method for storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.
2. (original) The method of claim 1, further comprising preparing said member with markings to facilitate placement of said writings on said member.
3. (original) The method of claim 2, further comprising moving said member from a retracted position to an exposed position prior to storing said writings.
4. (previously presented) The method of claim 3, wherein said member comprises a plank.
5. (previously presented) The method of claim 4, wherein said moving said member comprises sliding said plank to said exposed position.
6. (previously presented) The method of claim 3, wherein said member comprises a drawer.

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7. (original) The method of claim 6, wherein said moving said member comprises sliding said drawer to said exposed position.
8. (original) The method of claim 3, further comprising protecting said writings with said piece of furniture when said member is in said retracted position.
9. (previously presented) The method of claim 8, wherein said writings commemorate a specific time in history, person, or historical event.
10. (original) The method of claim 9, wherein said writings comprise a signature.
11. (original) The method of claim 9, wherein said writings comprise a date.
12. (original) The method of claim 1, wherein said writings comprise a carving, wood burning, etching, brush marks, imprint or stamp.
13. (original) The method of claim 1, further comprising storing memorabilia associated with said writings in a storage compartment in said piece of furniture.
14. (original) The method of claim 2, wherein said markings comprise grooves.

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15. (original) The method of claim 14, wherein said writings are organized into parallel rows using said grooves as guides.

16-27. (cancelled)

28. (previously presented) The method of claim 1, further comprising specifically designating said member as being intended to receive said handwritten writings in materials presented with said furniture when said furniture is offered for sale and has not yet received said handwritten writings.

29. (previously presented) The method of claim 1, wherein said surface comprises a wooden surface.

30. (previously presented) The method of claim 2, wherein said markings comprise a genealogical form.

31. (previously presented) The method of claim 30, wherein said genealogical form comprises a family tree.

32. (previously presented) The method of claim 30, wherein said genealogical form comprises a pedigree chart.

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IX. Evidence Appendix

None

X. Related Proceedings Appendix

None

XI. Certificate of Service

None